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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/091,467 | 03/07/2002 | Yasumasa Otsuka | 03500.016269 | 9039 |
| 5514 | 7590 | 01/13/2004 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | BRAUN, FRED L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2852 | |
| DATE MAILED: 01/13/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/091,467

Applicant(s)

OTSUKA ET AL.

Examiner

Fred L. Braun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-16 and 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 10, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The abstract as amended on October 10, 2003 still fails to set forth a concise statement of that subject matter which applicants consider to be their contribution to the art to which the invention pertains. More specifically, the abstract merely sets forth subject matter that is already well known in the art as evidenced by the patent to Murooka et al which was discussed in paragraph 9 on page 5 of paper No 6 and mailed to applicants on July 10, 2003.
3. Claims 1-9, 12-16 and 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murooka et al.

Applicants statements in the remarks filed on October 10, 2003 have been given careful consideration; however they are not deemed persuasive for the reasons set forth hereinbelow. More specifically, applicants allege on pages 9-12 of their remarks filed on October 10, 2003 that the patents to Suzuki et al, Yano et al and /or Oda et al, respectively, either alone or in combination fail to disclose the heater having a metallic substrate with a convex surface on one side of the fuser nip and a concave surface on an opposite side of said nip wherein said heater is fixed and held by a holder so as not to rotate with respect to the heating or fuser apparatus as now recited in amended base claims 1 and 14, and in newly submitted base claims 19 and 24, respectively. In response to these allegations, it is submitted that said allegations are moot in view of the disclosure and claims set forth in the patent to Murooka et al as previously noted in paragraph 9 on page 5 of paper No 6 and as further noted hereinbelow. Applicants further broad

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allegation on page 12 of their remarks filed on October 10, 2003 that they reviewed the other art of record and submit that the subject matter recited in newly submitted base claims 19 and 24 are neither taught nor suggested by that art is not considered to be well taken, especially in view of the fact that the patent to Murooka et al was specifically applied against originally filed claims 15, 16 and 18 in paragraph 9 on page 5 of paper No 6 and applicants remarks, noted supra, made no specific mention of the patent to Murooka et al in spite of the specific requirements to do so in accordance with 37 CFR 1.111(b) and 37 CFR 1.111(e), respectively.

Accordingly, with respect to claims 8, 15, 16, 19, 22 and 24, respectively, for example, of the subject application, it is submitted that the patent to Murooka et al discloses an image heating apparatus R (Fig. 24) for heating an image formed on a recording material P (Figs 24 and 26) wherein the heater 120 (Figs 24 and 26) includes a metallic substrate 120a (Figs 24 and 27) fixed to a holder 102 (Figs 24 and 26) so as not to rotate with respect to said heating apparatus R; a film 103 (Fig 24 and 26) moving in contact with said heater; a backup roller 104 (Figs 24 and 26) for forming a nip N (Figs 24 and 26) with said heater 120 via said film 103a wherein said heater 120 has a convex surface 120 (Fig 27 and column 16, lines 32-40) on a side of the nip N and a concave surface on the opposite surface of said nip (column 16, lines 22-31); a first insulating layer 120n (Figs 26 and 27) on said convex surface; a heat generating resistor layer 120b (Figs 26 and 27) on said first insulating layer; and a second insulating layer 120p (Figs 26 and 27; column 7 lines 1-14, column 15, lines 33-43 and column 18, lines 1-8, respectively) on said heat generating layer 120b wherein said second insulating layer 120p (Figs 24 and 26) is in

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contact with said film 103a. As to claims 2, 3, 12, 15, 18, 20, 23 and 25, respectively, of the subject application, it is submitted that column 3, lines 52-58; column 6, lines 43-56; and column 16, lines 22-40, respectively, of Murooka et al suggests to one having ordinary skill in the art that the heater substrate is formed by bending a metallic plate having a thickness of 0.6 mm or in the range of 0.5 mm to 2 mm, as recited in claims 12, 18 and 23, to form an arch-shape or a convex surface on which the heat generating resistor is provided or formed, as recited in claims 15, 20 and 25, respectively. With respect to claim 6 of the subject application, it is submitted that it is obvious to one having ordinary skill in the art that the holder 102 disclosed in column 15, line 44 through column 16, line 16 of Murooka et al functions as a guide surface for guiding the film 103a of same in the same manner that applicants holder 13(Fig. 1) functions as a guide for the film 21 (Fig. 1) as disclosed on page 6, lines 16-27 and page 15, lines 11-24, respectively, of the subject application. It is further submitted that it is obvious to one having ordinary skill in the art that the width of the fuser nip N (Fig. 26) of Murooka et al is less than the width of the metallic substrate 120a (Fig. 26) in a moving direction of the recording material P (Fig. 26), as recited in claim 9 of the subject application.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-9, 12-16 and 18-25 are further rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 6, 11, 12 and/or 16, respectively, of U.S. Patent No. 6,583,389 to Murooka et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is submitted that it is obvious to one having ordinary skill in the art that the metallic heater substrate 120 of Murooka et al is fixed to the holder 102 of same so that the heater substrate does not rotate with respect to the image heating apparatus; (2) that a backup roller .104 is used to form the fuser nip N between the heater substrate and said backup roller via a film 103a of Murooka et al; and (3) that the heat generating resistor 120b of Murooka et al is on the convex surface of said metallic heater substrate of Murooka et al, as recited in claims 8, 15, 21 and 22, respectively, for example, of the subject application.

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6. Any inquiry concerning this communication should be directed to Fred L. Braun at telephone number (703) 308-0128.

Fred L Braun
FRED L BRAUN
PRIMARY EXAMINER
ART UNIT ~~2852~~

F L BRAUN/pj

01/02/04